



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,436	06/09/2006	Sami Haakana	0696-0222PUS1	8935

2292 7590 04/30/2009
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

REDDY, SATHAVARAM I

ART UNIT	PAPER NUMBER
----------	--------------

1794

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

04/30/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/552,436	Applicant(s) HAAKANA ET AL.	
	Examiner SATHAVARAM I. REDDY	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/6/2005, 2/6/2006, 9/25/2008</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claim 5, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 4, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Eastman (US 3,250,614).**

Regarding claim 1, Eastman (US 3,250,614) discloses a method of using a polymer coated paper with a printing surface is formed of polysiloxane (silicone resin)

Art Unit: 1794

(col. 2, lines 42-64) where the printing ink is removed and the surface is cleaned with a solvent such as acetone (col. 4, lines 22-40) and reprinting of the surface is done afterward (col. 1, lines 11-25).

Regarding claim 4, Eastman (US 3,250,614) discloses the printing performed by electrophotographic means by applying toner to the printing surface in an electric field (col. 1, lines 11-25; col. 4, lines 22-40).

Regarding claim 5, Eastman (US 3,250,614) discloses the solvent for removing the printing ink being acetone (col. 4, lines 22-40).

Regarding claim 9, Eastman (US 3,250,614) discloses the use of a polysiloxane coating (silicone resin) formed on a fibrous substrate (paper) as a repeatedly used surface of electrographic prints (col. 2, lines 42-64; col. 1, lines 11-25) and the surface being cleaned with an organic solvent for removing the printing ink (col. 4, lines 11-20).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1794

7. Claims 2, 3 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eastman (US 3,250,614) in view of Onuma et al (US 5,605,778).

Eastman is relied upon as described above.

Regarding claims 2 and 3, Eastman (US 3,250,614) discloses the fixing of a toner to a printing surface by fusion (col. 4, lines 11-20) and the invention as claimed in claim 1.

Eastman (US 3,250,614) does not appear to explicitly disclose a polymer-based toner comprising a styrene-acrylate copolymer.

However, Onuma et al (US 5,605,778) discloses a polymer-based toner comprising a styrene-acrylate copolymer (col. 11, lines 49-67; col. 12, lines 1-7).

Regarding claims, 6 and 7, Eastman (US 3,250,614) discloses a printed product of a polysiloxane (silicone resin) coated paper (col. 2, lines 42-64) and removal of a printing ink by an organic solvent such as acetone where the surface of the coating is undamaged (col. 4, lines 35-37).

Eastman (US 3,250,614) does not appear to explicitly disclose a polymer-based toner comprising a styrene-acrylate copolymer.

However, Onuma et al (US 5,605,778) discloses a polymer-based toner comprising a styrene-acrylate copolymer (col. 11, lines 49-67; col. 12, lines 1-7).

Regarding claim 8, Eastman (US 3,250,614) discloses the printed product having polysiloxane on both sides (col. 2, lines 39-64) and having at least one side comprising a print (col. 4, lines 22-40).

Eastman (US 3,250,614) and Onuma et al (US 5,605,778) are analogous art because they are from the same field of electrographic printing.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Eastman (US 3,250,614) and Onuma et al (US 5,605,778) before him or her, to modify the electrographic print of Eastman (US 3,250,614) to include the styrene-acrylate copolymer toner of Onuma et al (US 5,605,778) in that having a toner of styrene-acrylate copolymer provides developing performance, fixability, durability and cleaning performance.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ituya et al (US 4,530,595) and Ohno et al (US 6,346,356). These references are pertinent in that they refer to electrographic printing. "major industrial

Art Unit: 1794

polymers." Encyclopedia Britannica. 2009. Encyclopedia Britannica Online. 22 Apr. 2009 <<http://www.britannica.com/EBchecked/topic/1426103/industrial-polymers> is pertinent> in that it refers to polysiloxane or silicone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SATHAVARAM I. REDDY whose telephone number is (571) 270-7061. The examiner can normally be reached on 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on (571) 272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SATHAVARAM I REDDY
/SIR/
Examiner, Art Unit 1794

/Kevin M Bernatz/
Acting SPE of Art Unit 1794

April 24, 2009